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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/900,360
Filing Date: July 25, 1997
Appellant(s): OBRECHT, WELLS

Elliott Goldberg (Reg. No. 33,347) for Terrell C. Birch (Reg. No. 19,382)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 17, 2004 and the remand from the Board of Patent Appeals and Interferences dated November 28, 2008.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

In response to entry of Applicant's after-final amendment (filed June 17, 2004), the Examiner has withdrawn the rejection under 35 U.S.C. § 112, 2nd paragraph of claims 1-9 only and the objections to claims 15 and 19. However, new rejections under 35 U.S.C. § 101 and § 112, 2nd paragraph are added below.

Therefore, the following issues remain before the Board of Patent Appeals and Interferences:

Whether the rejection of claims 17 and 18 under 35 U.S.C. § 112 has been overcome.

Whether the rejection of claims 1-3 under 35 U.S.C. § 103(a) is proper and legally correct.

Whether the rejection of claims 4-20 under 35 U.S.C. § 103(a) is proper and legally correct.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The disclosure does not provide a specific algorithm for performing the functionality corresponding to all of the means recited throughout claims 10-20. A specific algorithm for performing each function is required in order to meet requirements under 35 U.S.C. § 112, 6th paragraph. The specification also fails to clearly set forth which structural element corresponds to each recited means. It is not clear what the metes and bounds of the means recited throughout claims 10-20 are. Please refer to http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_6th_09_02_2008.pdf

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Claims 1-20 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing; therefore, claims 1-20 are non-statutory under § 101. It is also noted that the mere recitation of a machine in the preamble with an absence of a machine in the body of a claim fails to make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

Claim 1 is not tied to any machine at all; therefore, this claim is non-statutory.

Claims 2-9 recite that a computer receives the request; however, this is a nominal tie to a machine (analogous to insignificant post-solution activity) and the computer is not a "particular machine" as a computer preempts all machines that compute. Therefore, these claims are non-statutory.

Claims 3-9 also recite that selecting is performing by a central computer. The central computer is not a "particular machine" as a computer preempts all machines that

compute (and “central” is merely a non-functional descriptor of the computer).

Therefore, these claims are non-statutory.

Claims 4-9 also recite that transmitting is done by an internet system; however, this is a nominal tie to a machine (analogous to insignificant post-solution activity) and the internet system is not a “particular machine” as an internet system preempts all machines that facilitate communications via the internet. Therefore, these claims are non-statutory.

Claims 5-9 also recite that receiving is done by the central computer; however, this is a nominal tie to a machine (analogous to insignificant post-solution activity) and the central computer is not a “particular machine” as a computer preempts all machines that compute (and “central” is merely a non-functional descriptor of the computer). Therefore, these claims are non-statutory.

Claims 6-9 also recite that the compiling and ranking are performed by the central computer. The central computer is not a “particular machine” as a computer preempts all machines that compute (and “central” is merely a non-functional descriptor of the computer). Therefore, these claims are non-statutory.

Claims 7-9 recite that the “accessing by the buyer is performed by an internet connection.” There is no specification as to which machine is used to establish the internet connection; therefore, there is no tie to a particular machine.

In accordance with the new grounds of rejection asserted under 35 U.S.C. § 112, 2nd paragraph, it is not clear what the metes and bounds of the means recited

throughout claims 10-20 are; therefore, these claims fail to clearly establish a tie to a particular machine.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because, while Appellant lists five separate groupings, Appellant argues the same basic arguments as applicable to all of claims 1-20. Therefore, claims 1-20 are constructively interpreted as standing or falling together in one group.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

McKenzie, Kevin. "Car Sales Firm Represents Buyers Looking for a Good Deal" The Commercial Appeal, Final edition, Business section, page B3, July 6, 1992.

Barciela, Susana. "Need a Car But Hate to Haggle? Service Will Negotiate for You" Miami Herald, Final edition, Business section, page 31BM, March 23, 1992.

"Southern California Gets New Service that Makes Car Dealers Bid for Customers' Business" PR Newswire, page 0128A4482, January 28, 1992.

Laugesen, Wayne. "Here's a New Way of Buying a Car" Consumers' Research Magazine, vol. 75, no. 9, page 21(3), September 1992.

Anonymous. "Honestly the Best Policy" British Telecom Journal, vol. 8, no. 3, pages 32-33, 1987.

Reilly, Bob. "Firms Join Virtual Marketplace" Mesa Tribune, sG, page 1, July 16, 1994.

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the limitation “vehicle computers or appliances” (in line 2 of claim 17) should read as “vehicle computers” (i.e., computers associated with a vehicle) or “appliances” or if it should be read as “vehicles, computers, or appliances.” For examination purposes, “vehicle computers or appliances” will be interpreted as “vehicles, computers, or appliances.”

Appropriate correction and/or clarification are required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over CarBargains, as disclosed in the following references:

McKenzie ("Car Sales Firm Represents Buyers Looking for a Good Deal");

Barciela ("Need a Car But Hate to Haggle? Service Will Negotiate for You");

PR Newswire ("Southern California Gets New Service That Makes Car Dealers Bid for Customers' Business"); and

Laugesen ("Here's a New Way of Buying a Car")

in view of Interax, as disclosed in the article, "Honestly the Best Policy."

CarBargains discloses a method for purchasing goods or services from a seller by a buyer comprising:

[Claim 1] (a) receiving a request from a buyer for goods or services with a predetermined plurality of criteria related to the goods or services (McKenzie: ¶ 4; Barciela: ¶ 6);

(b) selecting at least one seller from a predetermined group of sellers of the goods or services based on the received predetermined plurality of criteria (McKenzie: ¶¶ 5-6 -- CarBargains calls at least five car dealers, who then submit bids through CarBargains. Presumably, CarBargains is contacting dealerships who they know at least sell the desired make of car, e.g., Lexus, Honda, etc.);

(c) transmitting the request of the buyer to the selected at least one seller of the goods or services (McKenzie: ¶ 5; Barciela: ¶ 7);

(d) receiving, within a predetermined time interval, responses from the at least one seller to the request (McKenzie: ¶ 5; Laugesen: ¶ 37 -- Responses are received within two weeks);

(e) compiling information provided in the responses received from at least one seller within the predetermined time interval (McKenzie: ¶¶ 5-7; Laugesen: ¶ 37 -- Responses are received and compiled to be given to the buyer within two weeks);

(g) providing the compiled responses of the selected seller for access by the buyer (McKenzie: ¶¶ 5-7).

Regarding claim 1, CarBargains provides buyers with lists of quotes from various car dealers; however, CarBargains leaves the comparison of the car dealers and their respective offers up to the buyer. In other words, CarBargains does not expressly teach a ranking of the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking. Interax makes up for this deficiency in its teaching of an on-line quotation system “which captured a customer’s individual requirements and provided a list of insurance companies instead of simply obtaining one quote at a time. The list was ranked in order, not just by cost but also by projected bonuses and past performance as well” (“Honestly the Best Policy”: page 33, column 2). The provision of an automatically generated list of ranked insurance companies facilitates the quick and confident selection of an insurance company that best meets a customer’s needs, thereby implying that it is desirable for a customer to select an insurance company with the relatively highest ranking since such

an insurance company would likely best fit the customer's needs. Both CarBargains and Interax provide brokerage services for assisting customers in easily locating vendors who best meet the customers' needs regarding desired products or services; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with CarBargains' service the step of "(f) ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking" in order to facilitate the quick and confident selection of a car dealership whose offer best meets the car buyer's needs, thereby implying that it is desirable for the buyer to select a car dealership with the relatively highest ranking since such a dealership would likely best fit the buyer's car and financial needs.

[Claims 2, 3] As per claims 2 and 3, CarBargains' requests are made over the telephone; CarBargains fails to expressly teach the receipt of a request via a computer or the selection of at least one seller via a central computer. However, Interax discloses that its "[i]nsurance quotations could be obtained on-line through a Prestel gateway from software run by the insurance companies themselves" ("Honestly the Best Policy": page 33, column 1). Further, "Interax acts as an electronic librarian, ensuring that comparative information is presented to the broker so he can offer his customer the best advice" ("Honestly the Best Policy": page 33, caption under picture at top of page). The conversion of this insurance comparison process from a manual process to a computerized one addresses the problem that "as the number of such 'electronic

ratebooks' increases the comparison process becomes complex and very time-consuming. What is required is the electronic equivalent of a librarian to 'open the books at the right page' to ensure that comparative information is presented to the broker in a logical and meaningful manner." ("Honestly the Best Policy": page 33, column 1) In other words, it is old and well-known that the automation of a manual process typically promotes more accurate and rapid processing of large amounts of data. Therefore, the Examiner asserts that it would have obvious to one of ordinary skill in the art at the time of Applicant's invention to implement CarBargain's step of receiving a request from a buyer via a computer and the step of selecting at least one seller using a central computer in order to promote more accurate and rapid processing of large amounts of data, thereby enhancing CarBargain's ability to handle an increased volume of requests for car quotes from its customers.

Claims 4-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over CarBargains, as disclosed in the following references:

McKenzie ("Car Sales Firm Represents Buyers Looking for a Good Deal");

Barciela ("Need a Car But Hate to Haggle? Service Will Negotiate for You");

PR Newswire ("Southern California Gets New Service That Makes Car Dealers Bid for Customers' Business"); and

Laugesen ("Here's a New Way of Buying a Car")

in view of Interax, as disclosed in the article, "Honestly the Best Policy," as applied to claim 3 above, and *further in view of* Reilly ("Firms Join Virtual Marketplace").

[Claims 4, 7] Regarding claims 4 and 7, neither CarBargains nor Interax explicitly teaches the use of the Internet to transmit the request of the buyer to the at least one seller or to allow the buyer to access the compiled responses of selected sellers. However, Reilly makes up for this deficiency in his discussion on how the Internet is used for various business activities, including comparing prices and accepting bids in a marketplace (§ 4). The Internet provides a relatively inexpensive forum where businesses can “advertise to a global market” (§ 13), thereby expanding a business’ customer base and potential for income/profit. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to adapt CarBargains’ service to be accessible over the Internet such that the Internet is used to transmit the request of the buyer to the at least one seller or to allow the buyer to access the compiled responses of selected sellers in order to provide a relatively inexpensive forum where CarBargains can “advertise to a global market” (Reilly: § 13), thereby expanding its customer base and potential for income.

[Claims 5, 6] As per claims 5 and 6, CarBargains’ receipt of responses from at least one seller and compiling of information provided in the responses are made over the telephone and/or by hand; CarBargains fails to expressly teach that the receipt of responses from at least one seller, the compiling of information provided in the responses, and the ranking of sellers are performed by a central computer. However, Interax discloses that its “[i]nsurance quotations could be obtained on-line through a

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Prestel gateway from software run by the insurance companies themselves” (“Honestly the Best Policy”: page 33, column 1). Further, “Interax acts as an electronic librarian, ensuring that comparative information is presented to the broker so he can offer his customer the best advice” (“Honestly the Best Policy”: page 33, caption under picture at top of page). The conversion of this insurance comparison process from a manual process to a computerized one addresses the problem that “as the number of such ‘electronic ratebooks’ increases the comparison process becomes complex and very time-consuming. What is required is the electronic equivalent of a librarian to ‘open the books at the right page’ to ensure that comparative information is presented to the broker in a logical and meaningful manner.” (“Honestly the Best Policy”: page 33, column 1) In other words, it is old and well-known that the automation of a manual process typically promotes more accurate and rapid processing of large amounts of data. Therefore, the Examiner asserts that it would have obvious to one of ordinary skill in the art at the time of Applicant’s invention to implement CarBargain’s steps of receiving responses from the at least one seller to the request, compiling information provided in the responses received from at least one seller within the predetermined time interval, and ranking the sellers based upon the compiled information by a central computer in order to promote more accurate and rapid processing of large amounts of data, thereby enhancing CarBargain’s ability to handle an increased volume of requests for car quotes from its customers.

CarBargains discloses a method for purchasing goods or services from a seller by a buyer:

[Claim 8] wherein the goods are selected from the group consisting of vehicles, computers, or appliances and the services are selected from the groups consisting of legal, financing, medical, or insurance (McKenzie: ¶ 4);

[Claim 9] wherein the goods are vehicles (McKenzie: ¶ 4).

[Claims 10-18] Claims 10-18 recite limitations already addressed by the rejection of claims 1-9 above; therefore the same rejection applies. Furthermore, it should be noted that CarBargains teaches the selection of at least two providers (instead of “at least one”). CarBargains contacts “at least five dealers in the local area” (McKenzie: & 5), thereby addressing this limitation.

[Claims 19-20] Claims 19-20 recite limitations already addressed by the rejection of claims 1-9 above; therefore the same rejection applies. Furthermore, it should be noted that CarBargains teaches the selection of at least two providers (instead of “at least one”). CarBargains contacts “at least five dealers in the local area” (McKenzie: & 5), thereby addressing this limitation.

As per claim 20, CarBargains is used to locate cars of interest for a buyer; however, it does not expressly state that a buyer requests a previously owned automobile *per se*. This difference is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same

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regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Furthermore, Official Notice is taken that the sale of previously owned automobiles is old and well-known in the art of automobile sales. By selling both new and previously owned automobiles, a dealer or automobile broker expands his/her customer base, thereby increasing one's likelihood of generating income/profit. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt CarBargains to find both new and previously owned automobiles for its buyers in order to expand its customer base, thereby increasing the likelihood of generating income.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The disclosure does not provide a specific algorithm for performing the functionality corresponding to all of the means recited throughout claims 10-20. A specific algorithm for performing each function is required in order to meet requirements

under 35 U.S.C. § 112, 6th paragraph. The specification also fails to clearly set forth which structural element corresponds to each recited means. It is not clear what the metes and bounds of the means recited throughout claims 10-20 are. Please refer to http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_6th_09_02_2008.pdf

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a

specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, “Process claim that recites fundamental principle, and that otherwise fails ‘machine-or-transformation’ test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’” (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Claims 1-20 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing; therefore, claims 1-20 are non-statutory under § 101. It is also noted that the mere recitation of a machine in the preamble with an absence of a machine in the body of a claim fails to make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

Claim 1 is not tied to any machine at all; therefore, this claim is non-statutory.

Claims 2-9 recite that a computer receives the request; however, this is a nominal tie to a machine (analogous to insignificant post-solution activity) and the

computer is not a "particular machine" as a computer preempts all machines that compute. Therefore, these claims are non-statutory.

Claims 3-9 also recite that selecting is performing by a central computer. The central computer is not a "particular machine" as a computer preempts all machines that compute (and "central" is merely a non-functional descriptor of the computer). Therefore, these claims are non-statutory.

Claims 4-9 also recite that transmitting is done by an internet system; however, this is a nominal tie to a machine (analogous to insignificant post-solution activity) and the internet system is not a "particular machine" as an internet system preempts all machines that facilitate communications via the internet. Therefore, these claims are non-statutory.

Claims 5-9 also recite that receiving is done by the central computer; however, this is a nominal tie to a machine (analogous to insignificant post-solution activity) and the central computer is not a "particular machine" as a computer preempts all machines that compute (and "central" is merely a non-functional descriptor of the computer). Therefore, these claims are non-statutory.

Claims 6-9 also recite that the compiling and ranking are performed by the central computer. The central computer is not a "particular machine" as a computer preempts all machines that compute (and "central" is merely a non-functional descriptor of the computer). Therefore, these claims are non-statutory.

Claims 7-9 recite that the “accessing by the buyer is performed by an internet connection.” There is no specification as to which machine is used to establish the internet connection; therefore, there is no tie to a particular machine.

In accordance with the new grounds of rejection asserted under 35 U.S.C. § 112, 2nd paragraph, it is not clear what the metes and bounds of the means recited throughout claims 10-20 are; therefore, these claims fail to clearly establish a tie to a particular machine.

(11) *Response to Argument*

Regarding the rejection of claims 17 and 18 under 35 U.S.C. § 112, 2nd paragraph, Appellant argues that since the Board did not raise this rejection in their decision rendered on September 25, 2003, the Examiner cannot raise such a rejection (pages 5-6 of Appeal Brief). However, this issue was never presented before the Board and was therefore not considered during Appellant’s previous Appeal. Furthermore, Office policy is constantly evolving; therefore, one rejection that may have been applicable ten years ago may not be relevant now and vice-versa.

Regarding the art rejection of claim 1, Appellant argues:

Initially directing attention to claim 1, the Examiner correctly indicated that McKenzie did call at least 5 dealers who then submit bids. The Examiner then speculates “presumably, CarBargains [McKenzie] is contacting dealerships who they know at least sell the desired make or car, e.g., Lexus, Honda, etc.” But this statement does not address the specific step in claim 1 of “selecting at least two sellers from a predetermined group of sellers of the goods or services based on a received predetermined plurality of criteria.” (Emphasis added) (Page 9 of Appeal Brief)

The Examiner respectfully disagrees. McKenzie specifically states, “A car buyer would use the service by informing CarBargains of the make, model and style of the vehicle desired. From Washington, the service would call at least five dealers in the local area.” (¶¶ 4-5) For example, if a customer living in the Washington area contacts CarBargains and states that she is looking for a 1967 Mustang convertible, then CarBargains is going to contact at least five dealers in the local Washington area that, at the very least, are known to sell Mustangs (e.g., a Ford dealer). It is predetermined that the group of dealers (i.e., sellers) from which the at least five dealers are selected must be located in the local Washington area. It is also predetermined that these at least five dealers who are invited to bid against each other to provide the customer with the best price of the desired vehicle (McKenzie, ¶ 5) can actually provide the vehicle. In other words, a Honda dealer who strictly sells new and used Hondas is not going to bid on selling a Ford Mustang to a customer simply because the Honda dealer does not have Ford Mustangs to sell. Therefore, by knowing which dealers in the local area to contact and invite to bid to sell a particular make and model vehicle, CarBargains must have some predetermined understanding of which dealers are to be contacted in the first place, thereby addressing the claim limitation in question.

Regarding claim 2, Appellant broadly submits that “while the computers are known there is no motivating reason to provide a computer with the steps of claim 1” (page 10 of Appeal Brief); however, Appellant provides no support for this assertion. Appellant provides similar unsupported assertions regarding claims 3-6, 12, 14, and 15.

The Examiner maintains her position as set forth in the rejection of claims 2-6, 12, 14, and 15.

Regarding claim 1, Appellant argues:

At least recognizing that the base references do not disclose “a ranking of the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ratings,” the Examiner relies on Interax with the assertion that this makes up the deficiencies of the base references. As set forth in the Office Action, Interax “provides a device which captured a customer’s individual requirements and provided a list of insurance companies instead of simply obtaining one quote at a time. The list was ranked in order, not just by cost, but also by projected bonuses and past performance as well. (“Honestly the Best Policy,” page 33, col. 2).

Also in Interax one of the items considered include projected bonuses. How this relates to criteria of the buyer is not understood. This may be related to the ultimate price. Also Interax does not cure the innate deficiencies of the base references. (Pages 10-11 of Appeal Brief)

The claim limitation in question is “ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking.” Interax’s on-line quotation system “captured a customer’s individual requirements and provided a list of insurance companies instead of simply obtaining one quote at a time. The list was ranked in order, not just by cost but also by projected bonuses and past performance as well” (“Honestly the Best Policy”: page 33, column 2). The claim language does not expressly specify how the ranking of sellers occurs beyond the fact that the ranking is based upon the plurality of criteria set forth by the buyer. Interax provides a ranking of insurance companies in response to a customer’s individual insurance requirements, thereby implying that only those who address the

customer's requirements are ranked in the first place. Furthermore, the mere fact that Interax's customers are in search of insurance is itself a type of criteria related to the goods or services requested by a buyer (as recited in the claimed invention). Clearly, Interax teaches the ranking of insurance companies based on criteria associated with insurance, e.g., requirements set forth by the customer in addition to the fact that insurance is desired. Interax's service is analogous to that of CarBargains in the sense that both services assist customers in locating and selecting the best seller of a desired good or service; therefore, the Examiner maintains that, as set forth in the art rejection, the CarBargains-Interax combination indeed addresses the claim limitation in question.

Regarding claim 19, Appellant argues that the rejection of claims 1-9 do not address claim 19 because claim 19 recites five means; however, the Examiner asserts that the means recited in claim 19 merely refer to various components of a computer system. The rejection of claims 1-9 address the functionality that is also recited in claim 19 as well as why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to automate the performance of this functionality by a computer system and the various components thereof (including those recited in claim 19).

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692

Art Unit: 3692

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees

Kambiz Abdi /K.A/
Supervisory Patent Examiner
Art Unit 3692

Vincent Millin
Appeals Conference Specialist
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